

No. 15,418.

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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BERNARD H. STAUFFER,

*Appellant,*

*vs.*

SLENDERELLA SYSTEMS OF CALIFORNIA, INC.,

*Appellee.*

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## APPELLEE'S BRIEF.

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**FILED**

JUN 19 1957

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## APPELLEE'S BRIEF.

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### I.

### INTRODUCTION.

This is appellee's answer to "Appellant's Opening Brief" on file in the above-entitled action.

For brevity, plaintiff's exhibits are sometimes referred to as "PX" followed by the number of the exhibit (*e. g.*, "PX-1"), and defendant's exhibits are referred to as "DX" followed by the designating letter (*e. g.*, "DX-A"). All emphasis is ours unless otherwise noted. Appellant Bernard H. Stauffer is referred to hereinafter as plaintiff or "Stauffer," and appellee is referred to as defendant or "Slenderella."

## II.

### STATEMENT OF THE CASE.

#### (a) The Parties.

The plaintiff Stauffer is the owner of the Stauffer patent No. 2,240,679 in suit [Finding 4, R. 48], and is a partner in a business enterprise known as "Stauffer System" which operates or franchises salons providing reducing treatments for women [R. 98-100].

The defendant Slenderella Systems of California, Inc. is a California corporation operating in Los Angeles, California [Finding 2, R. 48]. It is a mere user of couches or "tables," as they are termed in the record, charged by Stauffer to infringe his patent in suit. The defendant does not manufacture or sell such tables.

#### (b) The Issues.

Although the Stauffer patent No. 2,240,679 in suit contains two claims, only claim 1 is involved here, the plaintiff at the trial having withdrawn his charge of infringement as to claim 2 [R. 73].

Having held claim 1 of the Stauffer patent in suit invalid, the District Court entered no findings of fact or conclusions of law as to its infringement by defendant's accused devices [R. 381]. Thus, the only issue presented by this appeal is as follows:

- (1) Is the judgment of the District Court, holding claim 1 of Stauffer patent No. 2,240,679 in suit invalid in law, supported by the evidence?

Appellant's Opening Brief [pp. 13-14] argues the issue of infringement and we completely answer this argument hereinafter, showing clearly that there is no infringement



of claim 1 of the Stauffer patent in suit. However, this issue was not determined by the District Court and is not a proper issue before this Court on this appeal.

**(c) The Stauffer Patent in Suit—Generally.**

The Stauffer patent No. 2,240,679 in suit [R. 392] is entitled "Muscle Relaxing Machine," and purportedly relates to "*mechanical means* to soothe, relax, and strengthen certain of the muscular areas of the human body . . . by *massage* of certain of the muscles of the spinal tract [p. 1, Column 1, lines 15-21]." In short, it is a mechanical means for massaging the human body.

The Stauffer patent in suit discloses a couch or "table" 10 upon which a user 12 lies, with the oscillatable "seat," applicator, or paddle 18 engaging the portion of the body to be massaged. The seat 18 is carried on a pair of upright supports 20 which are rotated together through arcs on pivots 21 by pitman rods 28 which are moved back and forth by cams, linkage, and pulleys driven by an electric motor 50. The detailed construction of the machine of the Stauffer patent is fully described in the record by Dr. Knapp [R. 200-205]. The only portion of the detailed construction of the Stauffer patent device that requires any consideration in this case is the movable applicator 18, its supports 20, and the nature of their movement. The other mechanical details are of no importance.

Couches or tables for providing mechanical massage to the human body were old in the art long prior to the Stauffer patent. As early as 1869, a patent issued to Taylor, No. 86,604 [R. 470] on a generally similar type of machine. Generally similar devices are shown in the patents to: Hardy *et al.*, No. 1,276,526 [R. 473], issued in 1918; Hardy, No. 1,391,893 [R. 477], issued in 1921;

Parker, No. 1,978,223 [R. 446], and Miller, No. 1,953,424 [R. 451], issued in 1934, and Hardy, No. 1,999,412 [R. 496], issued in 1935.

**(d) Detailed Construction and Operation of Stauffer Patent Machine.**

In the machine of the Stauffer patent in suit, the seat or applicator 18 and its supports 20 move between their full line and dotted line positions as shown in Fig. 2 of the patent drawing [R. 392], being so noted in the specification [R. 395, Col. 1, lines 63-68]. In both the full line and dotted line limit positions, the support 20 is on the same side of the vertical and the seat 18 is tilted with respect to the horizontal. Thus, it will be understood, *the seat or applicator 18 pivots through a small arc on one side only of an imaginary vertical line through the supporting pivot 21.* This specific limited movement is clearly described in the Stauffer patent specification as follows:

“The legs 20 as will be noted in the drawings are inclined toward the head A of the couch, the degree of inclination being relatively small, being of a probable maximum of 15 degrees from the vertical when in extreme forward position and approximately 5 degrees from the vertical when in the other extreme end stroke position. This arrangement causes the seat 18 to lie at a constant although variable angle with respect to the upper surface of the couch [R. 394, Col. 2, line 54, to R. 395, Col. 1, line 8].”

“. . . the degree of movement ranges from about minus 15 to minus 5 degrees from the vertical, thereby causing the manipulator to swing through a range of 10 degrees, during which interval the seat or manipulator support 20 at no time passes the vertical, hence movement imparted to a body lying thereon is

accentuated in that its greatest thrust or lift is in one direction only, the return movement being a lowering and receding movement as distinguished from a positive upward and forward lift . . . [R. 395, Col. 1, line 75, to Col. 2, line 11].”

“The machine of this invention is adapted to gently, yet forcibly lift the body in a direction toward the head of the user, a distance of approximately two (2) inches, and then to return the body to the point of beginning . . . [R. 395, Col. 2, lines 64-69].”

This limited movement of the supports 20 and its importance in the patent in suit was admitted by the patentee Stauffer at the trial as follows [R. 146-147]:

“Q. (By Mr. Harris): You are familiar with the fact, are you not, that in your patent in the drawing and in the specification of the patent there is described a device in which the support 20 moves only on one side of the vertical, through a small arc of about ten degrees, from about minus fifteen degrees to minus five degrees from the vertical?

“A. Yes, sir, I am familiar with it.

“Q. So far as your patent is concerned—we are not speaking now about your commercial machines in any way—but so far as your patent is concerned, that small arc of movement is a very important factor, is it not?

“A. It is, yes, sir.

“Q. And the purpose in the device described in the specification and illustrated in the drawings of your patent in suit, the purpose in limiting the travel of the seat 18 to an arc, which is on one side of the vertical, is to establish a better motion of the seat as it is applied to the human anatomy, is it not?

“A. That is correct, yes, sir.

“Q. As a matter of fact, Mr. Stauffer, you regard that motion applied through the travel of the seat, in your patent in suit, as it is applied to the body? In other words, that motion to and fro, running through that degree of angle we referred to, has the essential factors or features of your patent in suit, does it not?

“A. I would consider it important in the treatment process, yes, sir.

“Q. But you do consider it as the essential factor in your patent in suit, do you not?

“A. Well, I would say one of them.”

The limited motion of the supports and applicator of the Stauffer patent in suit was fully confirmed by the expert Dr. Knapp [R. 206-208], who pointed out that the movement of the support in the patent in suit is quicker in one direction than in the other [R. 204-205], and does not operate in simple harmonic motion [R. 228-229]. As will be shown hereinafter, this in itself distinguishes the table of the Stauffer patent in suit from defendant's accused tables.

As pointed out by plaintiff Stauffer at the trial, *the speed* of oscillation of the seat or “paddle” 18 of his patent in suit *is critical*, the preferred speed being 130 cycles per minute but being variable 30 cycles per minute above or below the preferred speed [R. 148]. It is to be noted that, although Stauffer admits such speed of oscillation to be critical, his patent in suit does not even mention this factor [R. 149]. In any event, this speed factor of the device of the Stauffer patent in suit also distinguishes it from defendant's accused tables in which the pads oscillate at a rate of about 186 cycles per minute [R. 227].

With the machine of the Stauffer patent in suit, the plaintiff-patentee claims that its operation effects a stretching effect on the muscles of a body thereon [R. 94-95], whereas the evidence shows that defendant's accused tables do not effect any stretching of the muscles [R. 311].

**(e) The File-wrapper History of the Stauffer Patent.**

In determining the metes and bounds of the claim and the nature of the alleged invention of the Stauffer patent, it is important to note the file-wrapper history of the patent application through the Patent Office. Such file-wrapper and its contents appear as Defendant's Exhibit B-1 [R. 399-441].

Sheet 1 of the original drawings [R. 412] filed with the original application for the Stauffer patent in suit was *quite different* from the corresponding sheet 1 of the drawings appearing in the issued patent [R. 392], a reproduction of the original application drawing being attached at the end of this Brief as "Plate I" and a reproduction of the corresponding drawing of the issued patent as "Plate II," for the convenience of the Court in comparing the two drawings.

In the original patent application drawing, Plate I, Fig. 2 in dotted lines shows the limits of movement of the seat 18 and its supports 20 [R. 405, lines 27-28], the left-hand dotted line limit position being to the left of the vertical and the right-hand dotted line limit position being on the right of the vertical. The supports 20 are shown in full lines in vertical position in Figs. 2 and 3 of the original drawing and the flat top of the seat 18 is shown in Fig. 2 in full lines as horizontal and parallel with the top of the couch.



Application claims 2, 3, 4, 5 and 6 [R. 408-409] as originally presented with the application for the Stauffer patent, were specifically limited to a construction in which the "body contacting member" [or seat 18] extended "in a plane horizontal with the top surface" of the couch.

The foregoing makes it abundantly clear that the Stauffer patent application as originally filed disclosed and claimed a machine in which the top of the applicator or "seat" 18 in its central position was horizontal and parallel with the top of the couch, but movable through a small arc from a tilted position on one side to a reversed tilted position on the other side of the central position.

The original claims were all rejected by the Patent Office as unpatentable over the prior art [R. 414].

The applicant Stauffer, through his attorney, then changed his drawing from the form shown in Plate I to that shown in Plate II, substantially limited his specification by amendment to specify in effect that all movement of his supports 20 is on only one side of the vertical, and amended his claims 1 and 5 to make it clear that the support 20 is always on one side of the vertical and that the seat 18 is "constantly inclined from the horizontal" [R. 415-419]. In making these amendments, Stauffer's attorney stated that such amendments to the specification "set forth the novelty of the invention [R. 419, lines 3-5]," and attempted to distinguish the claims from the prior art patents by the allegation that the Stauffer machine lifted the body more pronouncedly in one direction than in the other [R. 419, lines 9-11 and 19-26]. These amendments and remarks make it clear that if there is any invention in the machine shown in the Stauffer patent (which we deny) it is limited very particularly to a construction in which the seat or applicator 18 is always tilted [*i. e.*

“adapted to tiltingly move”] with respect to the horizontal and in which the supports 20 are always on only one side of the vertical.

The applicant Stauffer finally on January 25, 1940, presented to the Patent Office claim 10 of his application [R. 421], which is generally similar to claim 1 of the Stauffer patent in suit but broader. Such application claim 10 was then rejected by the Patent Office as unpatentable over the prior art [R. 424]. The applicant Stauffer then amended his application claim 10 to limit it to a construction in which there is only a “*single*” flat applicator which is “*tiltingly*” moved [R. 426], which amendments appear in long-hand on the face of claim 10 as originally presented [R. 421], a copy of such page of the file-wrapper of the Stauffer patent application being attached as “Plate III” hereto. As so limited by the applicant, claim 10 was allowed [R. 428], and as so amended appears as claim 1 of the Stauffer patent in suit.

It will thus be apparent that Stauffer started out with an application disclosing and claiming one type of machine, and then, through amendments to his drawing, specification, and claims wound up disclosing and asserting invention for something quite different. It is apparent from the record discussed above that Stauffer’s claim 10, as originally presented to the Patent Office and as shown without the interlineations on Plate III, was considered by the Examiner as unpatentable, the rejection was acquiesced in by the applicant Stauffer, and the claim was amended in two important respects [*i. e.*, “*single*” and “*tiltingly*”] as shown by such interlineations on Plate III.

It is defendant’s contention, of course, that claim 1 of the Stauffer patent in suit is so limited by the file-wrapper history that it is not conceivably infringed by defendant.

**(f) The Stauffer Patent as a Mere Paper Patent.**

If claim 1 of the Stauffer patent in suit is narrowly interpreted as indicated above, the patent is a mere paper patent and has enjoyed no commercial success whatever because the tables actually used and leased by plaintiff Stauffer have not been covered by the patent.

Plaintiff Stauffer candidly admitted that in all, except the first few, tables made by him the supports 20 for the applicator 18 have moved through an arc from one side of the vertical to the other side of the vertical and back [R. 142, 145-147]. This is the type of motion exemplified by the Stauffer "Home Unit" table in evidence as physical Exhibit 2 [R. 79]. It is the type of movement illustrated by the original drawing in the Stauffer patent application [Plate I, *infra*], which was later changed to indicate movement on only one side of the vertical [Plate II, *infra*].

Thus, it is defendant's contention that the commercial machine used by Stauffer is not covered by his patent and that the machine of the Stauffer patent has had no commercial success whatever.

**(g) The Defendant's Accused Machines.**

The defendant does not make or sell any machines, being a mere user of two slightly different types of accused machines [R. 166-167].

The drawings Exhibits 16 and 17 (physical exhibits) illustrate the two types of tables used by the defendant [R. 166-167]. The table shown in Exhibit 17 is substantially the same as that shown in Exhibit 16, with minor immaterial differences [R. 218-220]. The construction of defendant's table shown in Exhibit 16 was explained in detail by the expert witness Dr. Knapp [R. 208-215]. We



believe that following is a fair summary of Dr. Knapp's uncontroverted testimony as to the construction of both of defendant's tables.

The Slenderella table has a vertical steel framework rigidly supported on a base which rests on the floor. Above the framework is a horizontal table top which is supported on rocker arms 24 and 25 [PX-16] for oscillatory horizontal movement of the entire table top relative to the framework and base. Suitable mechanism is provided for providing such oscillatory movement of the table top as desired.

Extending up through a pair of parallel slots in the table top are a pair of generally vertical rocker arms 11 and 11A [PX-16], upon the top of each of which is a pair of pads 10. Such rocker arms are pivoted at their lower ends in bearings 19 carried by supports 13 which are fixed to and hang down from the oscillatable table top. By suitable pitmen, eccentrics, cams, motor, etc., the rocker arms may be oscillated independently or together to cause the pads on their upper ends to oscillate back and forth.

The general type of movement of the pads or applicators in defendant's tables is illustrated by the full scale drawing, defendant's Exhibit C (a physical exhibit), although the actual arc of movement in defendant's tables is less than that shown in this drawing [R. 222-224]. As will be noted, the supports for the pads in defendant's tables move through a short arc from a position on one side of the vertical to a position on the other side of the vertical, and back again. This movement is "simple harmonic" motion, whereas in the table of the Stauffer patent in suit the motion is quite different in that it is faster on one-half of the cycle than on the other one-half [R. 228-229].

In defendant's accused tables the pads are oscillated back and forth at a rate of about 186 oscillations per minute [R. 227], whereas in the device of the Stauffer patent the range of rate of movement is between 100 and 160 oscillations per minute [R. 148].

**(h) The Prior Art—Generally.**

The prior art patents primarily relied upon by defendant to establish the invalidity of the Stauffer patent in suit are the patents to Parker, No. 1,978,223 [R. 446]; Miller, No. 1,953,424 [R. 451], and Gunderman, No. 1,825,588 [R. 462]. The other prior art patents of record [R. 470-503] are included in the record to show what was before the Patent Office in considering the application for the Stauffer patent in suit and to show the general state of the prior art.

Elaborate working models of the pertinent operating mechanism of the Parker, Miller, and Gunderman patents are in the record as physical exhibits which will be helpful to the Court in understanding the operation of the prior art devices of these patents. Thus, physical Exhibit E is a photostatic enlargement of sheet four of the drawings of the Gunderman patent No. 1,825,588 [R. 464], and physical Exhibit F is a lucite model of the operating mechanism [R. 233]. Similarly, Exhibit G is an enlargement of sheet 3 of the drawings of the Miller patent No. 1,953,424 [R. 453], and Exhibit H is a lucite model of its operating mechanism [R. 243]. Exhibit I is a photostatic enlargement of sheet 1 of the drawings of the Parker patent No. 1,978,223 [R. 446], and Exhibit J is a lucite model of the operating mechanism thereof [R. 251-252].

By superimposing the lucite models over their respective photostats and indexing the operating models in the

correct position by means of the indexing buttons on the enlargements, the operating models can readily be operated by hand to demonstrate the actual operation of the devices shown in the prior art patents. Using this method, the expert Dr. Knapp demonstrated to the trial court the operation of the mechanism of the Gunderman patent [R. 233-235], of the Miller patent [R. 243-246], and the Parker patent [R. 252-253].

The detailed construction and operation of the devices of the prior art patents to Gunderman, Miller, and Parker was clearly and extensively explained by the expert witness Dr. Knapp [R. 230-255]. His testimony with regard thereto is summarized as follows:

Parker No. 1,978,223 [R. 446] shows a treatment table with an open slot 13a in its top (Fig. 1) through which extend six pairs of vertical supports 18 carrying curved body applicators 17 on their upper ends. All of the supports 18 are pivoted on pivots 36 near their lower ends and are connected to a pitman rod 27 which is reciprocated through a cam and eccentric 28 by a belt 30 driven by a motor 33. When the motor is operated, the supports 18 oscillate in simple harmonic motion on their pivots to move in a small arc from one side of the vertical to the other and back. The purpose of the device of the Parker patent is to provide mechanical means "to impart a massaging action to the muscles of the spinal processes" [R. 448, lines 8-10]. It is to be noted that the applicators of the Parker machine move from one side of the vertical through the vertical and on to the other side of the vertical, and then back, exactly as originally disclosed in the application for the Stauffer patent in suit [See: Section (e), above]. It was not until after Stauffer amended his specification and claims to limit his

movement to an arc on one side of the vertical that the Patent Office allowed him any claims.

The Miller patent No. 1,953,424 [R. 451, 453] shows a couch-like structure 20 for the therapeutic treatment of the human body, having a slot in its upper surface through which extends a support or arm having a pad 27 on its upper end, the arm being moved upwardly and longitudinally and back by a pitman rod 71 driven through suitable gearing by an electric motor 49. As stated in the Miller patent "The action thus produced is a comparatively slow pulsating movement at the rate of about 120 pulsations per minute [p. 3, lines 21-24]," which is within the same speed range of 100 to 160 cycles of the device of the Stauffer patent in suit [R. 148].

The Gunderman patent No. 1,825,588 [R. 462] shows a vibrating machine "having vibratory plates which may be used not only for the purpose of *massaging* and otherwise treating the feet but also susceptible of use in *manipulating* other parts of the body [p. 1, lines 21-25]." While no couch is shown in the Gunderman patent, it makes it plain that "the lower part of the body may be massaged or manipulated by the operator sitting on the plates, this massaging or manipulation increasing the circulation at this part of the body and in addition to exercising the muscles in the vicinity of the hips will also increase circulation of the blood and benefit the operator with respect to certain diseases, as piles [p. 2, lines 104-112]." The Gunderman patent in Figs. 1-5, inclusive [R. 462-464] shows a machine including *two* side-by-side oscillatable applicators 26 (as in defendant's accused machines). It also shows in Fig. 6 [R. 465] a *single* applicator 26 (as in the Stauffer patent in suit), the same being described in the specification [p. 2, lines 112-118].

The patents to Miller and Gunderman were not considered by the Patent Office in connection with the application for the Stauffer patent in suit, although the Parker patent was so considered.

### III.

#### SUMMARY OF ARGUMENT.

A. Appellant's Opening Brief does not comply with the rules and the appeal should be summarily dismissed.

B. Appellant's Opening Brief wholly misconstrues the judgment below.

C. The District Court's Findings of Fact, Conclusions of Law, and Judgment that claim 1 is invalid for lack of invention are amply supported by the evidence and should be sustained.

D. Infringement is not an issue before the Court on this appeal.

E. Defendant's machines do not infringe claim 1 of the Stauffer patent in suit.

1. Defendant's machines do not include certain of the important elements of claim 1 and thereby do not infringe;

2. Defendant's machines do not have the same mode of operation as that of the Stauffer patent device;

3. Defendant's machines do not produce the alleged results of the machine of the Stauffer patent.



IV.  
ARGUMENT.

A. Appellant's Opening Brief Does Not Comply With the Rules and the Appeal Should Be Summarily Dismissed.

The only findings of fact of the District Court charged by plaintiff to be erroneous are as follows:

"7. Claim 1 of said Letters Patent No. 2,240,679 in suit defines an assemblage of elements all of which were old in the prior art in which they operated in substantially the same way to produce substantially the same result, and such subject matter as a whole would have been obvious to and could have been produced by any person having ordinary skill in the art to which said subject matter pertains [R. 49]."

"8. Claim 1 of said Letters Patent No. 2,240,679 is wanting in invention [R. 49]."

The corresponding conclusions of law of the District Court charged by plaintiff to be erroneous are as follows:

"2. Claim 1 of said Letters Patent No. 2,240,679 in suit is invalid and void in law for lack of invention [R. 49]."

"3. The defendant, Slenderella Systems of California, Inc., is entitled to judgment against the plaintiff, Bernard H. Stauffer, dismissing the complaint with prejudice [R. 49]."

"4. The defendant, Slenderella Systems of California, Inc., is entitled to judgment on its first counterclaim herein for declaratory relief, adjudging claim 1 of said Letters Patent No. 2,240,679 in suit invalid and void [R. 50]."

Appellant's Opening Brief, although specifying the above findings of fact and conclusions of law to be erroneous in its Specification of Errors [pp. 4-5], makes no attempt whatever to show that such findings of fact by the District Court are erroneous, much less that they are clearly erroneous. Appellant's Opening Brief makes no attempt whatever to comply with Rule 18(d) of this Court which requires an appellant to state "as particularly as may be wherein the findings of fact and conclusions of law are alleged to be erroneous."

Rule 52(a) of the Rules of Civil Procedure provides:

“. . . Findings of fact shall not be set aside unless clearly erroneous. . . .”

Appellant's Opening Brief (p. 7) states: "The District Court *did not find* that the patent device was anticipated by the prior art, or *did not involve invention over the prior art.*" This statement in the Opening Brief, upon which appellant's entire argument is based, is obviously flatly wrong or highly misleading in view of the express Finding of Fact 7 and Conclusion of Law 2 quoted above.

We suggest that this appeal should be dismissed and the judgment of the Court below affirmed upon the ground that the Appellant's Opening Brief does not comply with the Rules.

## **B. Appellant's Opening Brief Wholly Misconstrues the Judgment Below.**

Appellant's Opening Brief, in the first section of its argument (pp. 7-8) entitled "The District Court Erred in Concluding That the Stauffer Device Is Too Simple to Be an Invention," states, with respect to the decision by the District Court: "It simply found the patented device too simple to be an invention (p. 7)" and ". . . the District

Court was not following the law when it held that the Stauffer device was just too simple to be an invention (p. 8).”

Even a perfunctory reading of the findings of fact, conclusions of law, and judgment below [R. 48-50] and the District Court’s brief oral opinion [R. 380-381] shows that the District Court neither concluded, found, nor held any such thing as attributed to it by Appellant’s Opening Brief. True, the District Court characterized the art in which the Stauffer patent is included as a *simple art*, but nowhere indicated that it was holding the Stauffer patent invalid merely because it is simple. On the contrary, the District Court held the Stauffer patent invalid for lack of invention because all of the elements of claim 1 were old in the prior art, and at best it was a mere matter of mechanical skill to put them together as Stauffer had done.

While we agree that the Stauffer patent shows and claims a ridiculously simple device, this was not the basis for the decision of the District Court and appellant’s argument with respect to simplicity is immaterial.

**C. The District Court’s Findings of Fact, Conclusions of Law, and Judgment That Claim 1 Is Invalid for Lack of Invention Are Amply Supported by the Evidence and Should Be Sustained.**

Finding of Fact 7 [R. 49] finds that claim 1 of the patent in suit: “. . . defines an assemblage of elements all of which were old in the prior art in which they operated in substantially the same way to produce substantially the same result. . . .” This finding of fact is amply supported by the evidence, as shown hereinafter.



Claim 1 of the Stauffer patent in suit is as follows:

“1. A muscle relaxing machine comprising a couch-like structure for repose of a human body in the top surface of which a slot-way is formed and through which a vertically directed and oscillatable support for a single flat rectangular applicator is adapted to tiltingly move, and means to oscillate said applicator axially of the length of said couch-like structure whereby zonular areas of the body may be massaged by mechanical manipulation in a substantially horizontal plane.”

Following we take each element of claim 1 of the Stauffer patent in suit (as a quoted subheading) and show where it appears in the prior art of record.

**“A muscle relaxing machine comprising a couch-like structure for repose of a human body. . . .”**

The Stauffer patent in suit makes it plain that such alleged muscle relaxation is accomplished by mechanical massage or manipulation of muscle areas of the body, stating:

“The machine of this invention relates to mechanical means to soothe, relax, and strengthen certain of the muscular areas of the human body . . . by massage of certain of the muscles of the spinal tract [R. 394, Col. 1, lines 15-21].”

Couch-like machines for the repose of a human body and which impart mechanical massage to zonal muscles or areas for the same general purpose are very old in the art.

The patent to Taylor No. 86,604 [R. 470] issued in 1869, shows such a couch-like machine, the effect of which “is soothing, laxative, and calculated to increase muscular action and development [p. 2, Col. 1].”

Similarly, the patent to Hardy No. 1,391,893 [R. 477], issued in 1921, shows such a couch-like machine having applicators which engage the body “so as to impart a rubbing motion over the surface of the body with which they contact, as nearly similar to the movement of the hand thereover as is possible with mechanical devices [p. 1, lines 50-54],” and which further states “The results of this *massaging operation* tend to set up the circulation in the vicinity of the spine and to thus energize the entire system, and the patient is *much invigorated and refreshed* [p. 1, lines 61-65].” To the same effect is the later patent to Hardy, No. 1,999,412 [R. 496].

Also, the patent to Parker No. 1,978,223 [R. 446] shows such a couch-like “Spinal Massage Apparatus,” adapted to “impart a massaging action to the muscles of the spinal processes [p. 1, lines 8-10].”

The patent to Miller No. 1,953,424 [R. 451] likewise shows such a couch-like structure.

**“ . . . in the top surface of which is a slot-way”**

Couch-like structures having such a “slot-way” are shown in the prior art patents to Parker [R. 446], Miller [R. 451, at 453], Taylor [R. 470], Hardy *et al.* [R. 473], Hardy '893 [R. 477], and Hardy '412 [R. 496].

**“ . . . a slot-way . . . through which a vertically directed and oscillatable support for a single flat rectangular applicator is adapted to tiltingly move. . . .”**

All of the foregoing prior art patents have vertically directed and oscillatable supports for an applicator.

In Parker [R. 446-447], they are the supports 18 which are vertically directed, extend through the slot-way 13a,

and oscillate about their pivots 36 from a position on one side of the vertical to a position on the other, and carry the applicators 17 on their upper ends.

Parker No. 1,978,223 shows multiple rounded applicators 17, not a *single flat rectangular* applicator as claimed in claim 1. A single applicator, however, is shown in each of the patents to Miller [R. 451] and Gunderman [Fig. 6, 465], neither of which were file-wrapper references considered by the Patent Office and none of the prior art before the Patent Office R. 470-503] showed a single applicator. The Miller patent, furthermore, shows an applicator pad 27 which is *flat* on top [See Fig. 4, R. 453].

It is plain, therefore, that no invention would be involved in merely using a single applicator in the Parker patent construction and making it flat on top.

In any event, if claim 1 of the Stauffer patent is limited to a single and flat applicator to save its validity, defendant's machines do not infringe because they use *four* applicators, none of which is flat on top, as will be developed hereinafter.

The other possible limitation in this quoted portion of claim 1 is that the "oscillatable support . . . is adapted to *tiltingly move*." Plaintiff, by its charge of infringement here, perforce contends that the applicator supports in defendant's tables so "tiltingly move." If this is true, then the applicator supports in the Parker and Gunderman patents likewise "tiltingly move" because they have the same simple harmonic motion as the supports of defendant's tables and are operated by substantially the same mechanism.

“. . . and means to oscillate said applicator axially of the length of said couch-like structure. . . .”

As pointed out by plaintiff-patentee Stauffer, this merely means that the applicator, pad, or seat is moved back and forth with respect to the top of the table [R. 342].

Obviously, the applicators 17 of the Parker patent oscillate back and forth lengthwise of the table in the same fashion; the applicator pad 27 of the Miller patent moves in the same way; the vibrating applicator plates 26 of the Gunderman patent move in the same way with respect to its base 11.

The limitation in claim 1 of Stauffer that the applicator moves "axially" of the length of the couch-like structure does not add any novelty. This means that it moves along the longitudinal center line of the couch. The same is true of the applicator 27 of the prior art Miller patent [R. 451].

Thus, all of the mechanical elements set forth in claim 1 of the Stauffer patent in suit were old in the prior art in which they operated in substantially the same way to produce substantially the same result, exactly as found by the District Court in Finding 7 [R. 49]. There is thus ample evidence in the record supporting Finding 7, and there being no evidence to the contrary, the finding is not in any respect erroneous as to its factual basis.

The law is well established that where, as here, all of the elements of the claim in suit are found in the prior art where they operate in substantially the same way to produce substantially the same result, the claim is invalid in law:

*See:*

*Kwikset Locks, Inc. v. Hillgren*, 210 F. 2d 483  
(C. A. 9th, 1954);

*Himes v. Chadwick*, 199 F. 2d 100 (C. A. 9th,  
1952).

Finding of Fact 7 [R. 49] goes on to find as a fact that the subject matter of claim 1 of the Stauffer patent in suit “as a whole would have been obvious to and could have been produced by any person having ordinary skill in the art to which said subject matter pertains.” Appellant’s Opening Brief makes no attempt whatever to show that this portion of Finding 7 is in any respect erroneous.

Finding of Fact 7, not seriously questioned by appellant, is determinative of this appeal when considered in connection with Section 103 of Title 35 of the United States Code as follows:

**“§103. Conditions for patentability; non-obvious subject matter.—**

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . .”

Claim 1 of the Stauffer patent in suit covers merely an assemblage of elements old in the prior art, and the District Court in holding it invalid properly followed the rule enunciated and applied in *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147; and by this Court in *Kwikset Locks v. Hillgren*, 210 F. 2d 483 (C. A. 9th, 1954), and *Oriental Foods, Inc. v. Chun King Sales, Inc.*, ..... F. 2d ....., 113 U. S. P. Q. 404 (C. A. 9th, May 16, 1957).

As stated by this Court in *Oriental Foods, Inc. v. Chun King Sales, Inc.*, *supra*:

“We believe that that patent involved in the instant cause rightfully belongs, to use the words of

Justice Douglas, among the 'list of incredible patents which the Patent Office has spawned.' 340 U. S. at 158. It is a trifling device at best. It makes no substantial contribution to the advancement of the arts . . . Placed aside the Constitutional criteria for invention, this device does not measure up."

#### D. Infringement Is Not an Issue Before the Court on This Appeal.

The District Court here entered no findings of fact or conclusions of law as to whether claim 1 of the Stauffer patent in suit is infringed by defendant's accused machines. Having held claim 1 invalid, it was unnecessary for the District Court to make any findings of fact or conclusions of law as to infringement.

See:

*Oriental Foods, Inc. v. Chun King Sales, Inc.*,  
..... F. 2d ....., 113 U. S. P. Q. 404 (C. A.  
9th, May 16, 1957).

If this Court affirms the decision of the District Court in holding claim 1 of the Stauffer patent in suit invalid in law, this Court not only need not, but, we suggest, should not consider the issue of infringement. See: *Oriental Foods, Inc. v. Chun King Sales, Inc.*, *supra*.

If this Court reverses the decision of the District Court as to the invalidity of claim 1 of the Stauffer patent in suit, the action should be remanded to the District Court with directions to it to enter suitable findings of fact and conclusions of law on the infringement issue. This procedure is indicated by the following authorities:

"The question of validity of the claims here involved cannot properly be determined on this appeal.



Such a determination would necessitate findings on questions on which the District Court has made no findings—the question of novelty and the question of invention, both of which are questions of fact. Such findings should be made by the District Court, not by this court.

“The judgment is vacated and the case is remanded to the District Court with directions to determine the question of validity of the claims here involved, determine the question of their infringement, make findings of fact and state conclusions of law, as required by Rule 52(a) of the Federal Rules of Civil Procedure, and thereupon enter such judgment as may be proper.”

*Helbush v. Finkle*, 170 F. 2d 41 at 42 (C. C. A. 9th 1948).

“The patent claims in suit being invalid, we will not decide or discuss the issues of infringement, upon which the district court made no findings. In *Hazeltine Corporation v. Crosley Corporation*, 6 Cir., 130 F. 2d 344, 349, *supra*, we asserted that, in patent cases as well as in mill-run civil actions, a reviewing court would violate both the letter and the spirit of Civil Procedure Rule 52, should it pass upon a controverted issue of fact not determined in the trial court. There, the district court, having held the patent claims in suit not to be infringed, had made no findings and had drawn no conclusions with respect to the validity of the patent. In the present case, having held the patent claims invalid, the district court made no findings with respect to infringement. The same reasoning applies. On this review, the issues of infringement should not be passed upon. In *Dow Chemical Company v. Halliburton Oil Well Cementing Company*, 324 U. S. 320, 65 S. Ct. 647,

*supra*, the Supreme Court expressly pretermitted decision upon infringement in like circumstances.”

*O’Leary v. Liggett Drug Co.*, 150 F. 2d 656 at 667 (C. C. A. 6th, July 1945).

*And see:*

*Stearns v. Tinker & Rasor*, 220 F. 2d 49 (C. A. 9th 1955).

As shown in the following sections of this brief, however, defendant’s accused machines clearly do not infringe claim 1 of the Stauffer patent in suit.

### **E. Defendant’s Machines Do Not Infringe Claim 1 of the Stauffer Patent in Suit.**

Appellant’s Opening Brief (pp. 13-14), in a curiously desultory fashion, argues infringement here.

To establish infringement of a patent, a plaintiff must establish that: (a) the accused device includes all of the elements of the claim in suit, in which (b) such elements operate in substantially the same way, (c) to produce substantially the same result.

*See:*

*Craftint Mfg. Co. v. Baker*, 94 F. 2d 369 (C. C. A. 9th 1938);

*Burgess Battery Co. v. Coast Insulating Corp.*, 114 F. 2d 779 (C. C. A. 9th, 1940);

*Air Device v. Air Factors*, 210 F. 2d 481 (C. C. A. 9th, 1954).

Merely reading the claim in suit on the accused structure, as Appellant’s Opening Brief (pp. 13-14) attempts to do, does not establish infringement.



See:

*Grant v. Koppl*, 99 F. 2d 106 (C. C. A. 9th, 1938);  
*Kemart Corp. v. Printing Arts Research Laboratories*, 201 F. 2d 624 (C. A. 9th, 1953).

We therefore suggest that appellant has wholly failed to carry its burden of proof to establish infringement, and that the decision of the District Court can properly be affirmed on this ground alone. However, the evidence in this action definitely and conclusively establishes non-infringement and this evidence and its effect is reviewed hereinafter.

**1. Defendant's Machines Do Not Include Certain of the Important Elements of Claim 1 and Thereby Do Not Infringe.**

Defendant's machines do not have "a single flat rectangular applicator" as defined by claim 1 of the Stauffer patent in suit. As shown in the drawings of defendant's machines, Exhibits 16 and 17, each machine has *two pairs* of applicators, side-by-side, as described by the expert Dr. Knapp [R. 210]. Claim 1 of the Stauffer patent was rejected by the Patent Office until the word "single" was inserted in the claim (*See*: Plate III appended hereto). Thus, it is a material limitation of claim 1 that it covers only a machine having a *single* applicator, and defendant's machines having *two pairs* of side-by-side applicators do not infringe.

It is elementary patent law, that where an applicant for a patent has specifically limited his claim to obtain its allowance and avoid the prior art, by the doctrine of "file-wrapper estoppel" the patentee cannot thereafter expand his claim to cover a device covered by the original

claim but not covered by the claim as so amended. The rule was concisely stated by Chief Justice Hughes in *Smith v. Magic City Kennel Club, Inc.*, 282 U. S. 784, at 789, 51 S. Ct. 291, 75 L. Ed. 707, as follows:

“The case, in our opinion, thus calls for the application of the principle that where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent. *Shepard v. Carrigan*, 116 U. S. 593, 597 . . . The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. *Sargent v. Hall Safe & Lock Co.*, 114 U. S. 63, 86; *Shepard v. Carrigan*, *supra*, 598; *Hubbell v. United States*, *supra*, 85. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, 429.”

*And see:*

*I. T. S. Rubber Co. v. Essex Rubber Co.*, 272 U. S. 429, 47 S. Ct. 136, 71 L. Ed. 335;

*Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U. S. 211, 61 S. Ct. 235, 85 L. Ed. 132.

Secondly, defendant's machines do not employ any *flat* applicators, defendant's applicators being rounded on top [See: the illustrative drawing of defendant's applicators, Ex. C], quite similar to the rounded applicator 26 of the Gunderman prior art patent [R. 462]. An applicator pad quite similar to those in defendant's machines is also shown in the prior art Miller patent [R. 451, see Fig. 4]. The Stauffer patent in suit shows a *flat* applicator or seat 18 [R. 392], and the plaintiff-patentee Stauffer testified in effect that it is essential in his patent in suit to use a *flat* applicator and not a curved applicator as shown in the Gunderman patent [R. 345-346]. Defendant's machines, omitting this essential element of claim 1 of the Stauffer patent, thereby avoid infringement, it being well established that the omission from a defendant's device of an essential element claimed in the patent in suit avoids infringement.

*See:*

*Burgess Battery Co. v. Coast Insulating Corp., supra.*

Furthermore, in defendant's machines the side-by-side pairs of applicators do not oscillate "axially" of the length of the couch as specified by claim 1 of the Stauffer patent in suit. In the Stauffer device the applicator 18 moves lengthwise of the couch along the center line or *axially*, whereas defendant's applicators move on paths on each side of the center line (as do the side-by-side applicators of the prior art patents to Parker [R. 446] and Gunderman [Figs. 2 and 4, R. 462, 463]).

Thus, defendant's machines omit several of the material structural limitations of claim 1 of the Stauffer patent and thereby avoid infringement.

2. Defendant's Machines Do Not Have the Same Mode of Operation as That of the Stauffer Patent.

The evidence establishes clearly that defendant's machines do not operate in the same way, *i. e.*, have the same "mode of operation," as the table of the Stauffer patent in suit, and thereby avoid infringement.

Mr. Stauffer's testimony made it very plain that to obtain the required "lifting effect" on a human body essential in his patent in suit it is essential to employ a *flat* applicator and that if rounded applicators, such as shown in the prior art patent to Gunderman, are used this "lifting effect" cannot be attained [R. 345-346]. As pointed out in the preceding section (Sec. E(1)) of this brief, defendant's machines use such rounded applicators. Dr. Fishbein definitely testified that in the operation of defendant's accused machines there is no "lifting effect" whatever on the human body [R. 301; 304-305] and this is uncontroverted. There is no evidence in this record that defendant's tables produce such a "lifting effect" and all of the evidence is to the contrary.

Furthermore, as pointed out above, in the machine of the Stauffer patent the support 20 for the flat applicator or seat 18 moves through an arc of about  $10^{\circ}$  on only one side of the vertical. Mr. Stauffer admitted that this type of movement is a *very important* factor in the operation of the machine of the patent in suit, and is one of its *essential* factors [R. 147]. The evidence is uncontroverted, however, that defendant's machines do not have this type of movement because in defendant's machines the supports for the applicators move through an arc from one side of the vertical to the other side of the vertical and back.

Sheet 1 of the original drawings in the application for the Stauffer patent [R. 412] showed a device in which the applicator support 20 moved in an arc from one side of the vertical to the other side of the vertical and back. The applicant Stauffer, however, amended his drawing to show the applicator support moving through an arc on only one side of the vertical, and amended his specification to so limit such movement of the applicator support 20 [R. 415-416]. Thus, although the original Stauffer application showed and claimed the type of movement of the applicator supports of the defendant's accused machines, Stauffer amended his application to show and define a movement on only one side of the vertical.

It is well established in the law that where an applicant cancels from the original application one form of his alleged invention, this constitutes a dedication to the public of such form cancelled, and the patentee cannot thereafter attempt to expand the claims of his patent to cover the specific form cancelled from his application.

*See:*

*Ruud Mfg. Co. v. Long-Landreth-Schneider Co.*,  
250 Fed. 860 (C. C. A. 2d, 1918);

*Lincoln v. Waterbury Button Co.*, 291 Fed. 594  
(D. C. Conn., 1923);

*Aeration Processes, Inc. v. Lange*, 196 F. 2d 981  
(C. A. 8th 1952).

Since, in defendant's machines the applicator supports do not move in an arc on only one side of the vertical, and since the Stauffer patent discloses and is limited to such a construction, defendant's tables do not have the same "mode of operation" as the device of the patent in suit and, therefore, do not infringe.



It is also to be noted that in the device of the Stauffer patent the applicator 18 moves faster in one direction than in the other [R. 204-205], presumably to provide the "differential up-stroking or lifting" described therein, while in defendant's machines the applicators move in *simple harmonic motion* equally fast in both directions [R. 228-229], an entirely different type of motion. This conception of moving the applicator faster in one direction than in the other was a function of the device originally claimed by Stauffer in original claims 5, 6, and 7 of his patent application [R. 409-410]. Thus, again, defendant's tables have a "mode of operation" different from that of the device of the Stauffer patent in suit.

The defendant's physical Exhibit K provides a ready comparison of the relative movement of the support 20 of the Stauffer patent in suit and the supports of the defendant's accused machines [R. 287-288.] It clearly shows that the arc of movement of the Stauffer applicator is entirely on one side of the vertical but that in defendant's machines the movement is on both sides of the vertical. Moreover, this exhibit clearly demonstrates that plaintiff's and defendant's arcs of movement *at no time* overlap, but are in fact wholly different.

It is further to be noted that claim 1 of the Stauffer patent requires that its applicator support "is adapted to *tiltingly* move." The word "tiltingly" was added to the claim to avoid a rejection by the Patent Office of the claim on the prior art. At the same time the specification of the Stauffer patent application was amended to state: "This arrangement causes the seat 18 to lie *at a constant* although variable angle *with respect to the upper surface of the couch* [R. 415]." Thus, the word "tiltingly" means simply that the upper surface of the seat or applicator 18

is always at an angle or tilted with respect to the top of the couch (as shown in the drawing of the Stauffer patent) [R. 264-266]. Defendant's applicators in their central positions of movement are substantially horizontal with respect to the top of the couch or table.

Thus, we submit, defendant's machines have a mode of operation entirely different from that of the machine of the Stauffer patent in suit and thereby avoid infringement.

### **3. Defendant's Machines Do Not Produce the Alleged Results of the Machine of the Stauffer Patent.**

The Stauffer patent in suit [R. 394] makes a long list of claims of therapeutic results and effects derived from the operation of its table (page 1, Column 1, line 15, to Column 2, line 4; page 2, Column 2, lines 11-64). Dr. Fishbein, defendant's accredited medical expert having wide experience with defendant's machines and having made extensive medical studies of their effects on women [R. 295-297], established in uncontroverted fashion that defendant's accused machines produce substantially *none* of these results claimed in the Stauffer patent [R. 297-305].

Although Mr. Stauffer contended that the machine of the Stauffer patent effects a stretching of the muscles of the body [R. 94-95], plaintiff made no attempt to establish that defendant's machines accomplish this, and Dr. Fishbein testified positively that defendant's machines do not stretch any muscles [R. 311]. This is merely illustrative.

There was no attempt made by plaintiff in the evidence to establish any similarity of results attained by defendant's accused machines and that of the Stauffer patent

in suit, and all of the defendant's evidence is to the contrary. Thus, we suggest, the record is clear that defendant's machines do not produce the same results claimed by plaintiff for the machine of the Stauffer patent in suit. This, in itself, establishes lack of infringement.

It is to be noted that the only issue here is a comparison between the construction and operation of the machine of the Stauffer patent in suit and defendant's accused machines. There is no comparison to be made between plaintiff's commercial machines and defendant's machines, because there is no evidence to show that plaintiff's present commercial machines (*e. g.*, PX-2) embody any alleged invention of the patent in suit. It is our position that plaintiffs' commercial machines do not embody the alleged invention of the Stauffer patent because: (a) they do not use a *flat* applicator, as shown and claimed therein; (b) the applicator moves on both sides of the vertical exactly as do the applicators of the prior art patents to Parker and Gunderman; and (c) the top of the applicator is not at all times tilted with respect to the horizontal as described and claimed in the Stauffer patent. True, Mr. Stauffer improperly testified (over our objection) that his commercial tables embody the invention of his patent [R. 102-103], but this is a mere legal conclusion and is not evidence.

We, therefore, submit that plaintiff has failed to establish infringement, because he has wholly failed to show that defendant's accused machines have the same elements which operate in substantially the same way to produce substantially the same results as the device of his patent in suit. We further submit that the evidence in this action clearly establishes the negative of each of these requirements for a determination of patent infringement.



V.

CONCLUSION.

The District Court held that claim 1 of the Stauffer patent in suit defines an assemblage of elements all of which were old in the prior art in which they operated in substantially the same way to produce substantially the same result, and that such subject matter would be obvious to any mechanic having ordinary skill in the art, and that by reason thereof claim 1 is invalid for lack of invention. Such findings and decision are amply supported by the evidence, and appellant has shown no error of any kind therein.

We respectfully submit that the decision of the District Court should be affirmed with costs to appellee.

Respectfully submitted,

HARRIS, KIECH, FOSTER & HARRIS,

FORD HARRIS, JR.,

NEWLIN, TACKABURY & JOHNSON,

HUDSON B. COX,

*Attorneys for Appellee.*



128  
52

2

679  
5-6-41

Print of drawing as originally filed.

Fig. 1

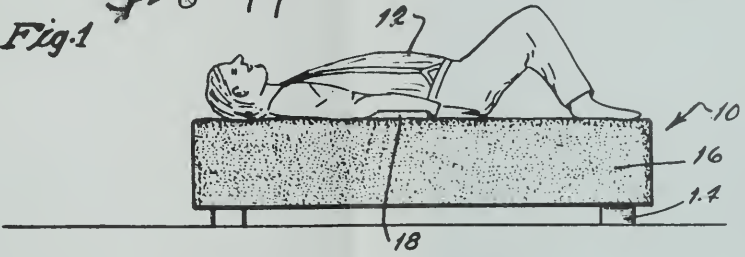
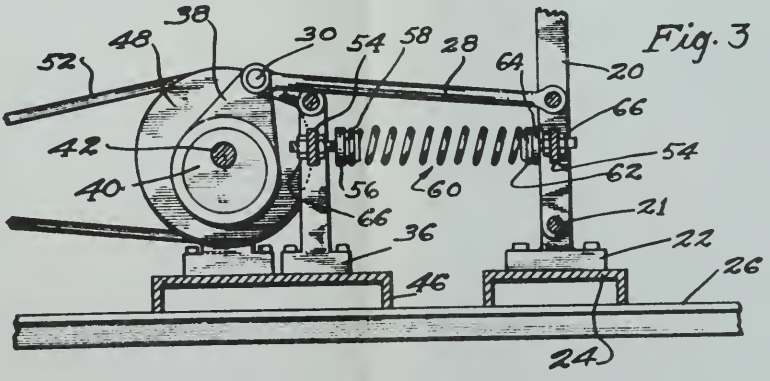
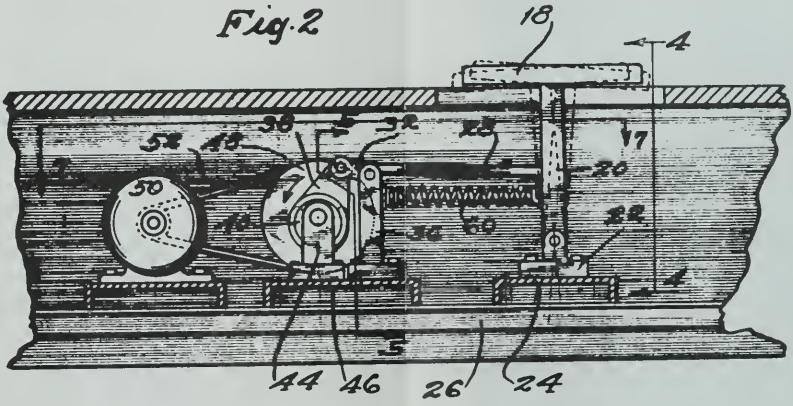


Fig. 2



my d... plate rough... cannot...  
It can be...

INVENTOR.  
Bernard H. Stauffer  
BY *Phil Woolley*  
ATTORNEY.

55

13 128-70

222327



May 6, 1941.

B. H. STAUFFER

2,240,679

MUSCLE RELAXING MACHINE

Filed Aug. 1, 1938

2 Sheets-Sheet 1

Fig. 1.

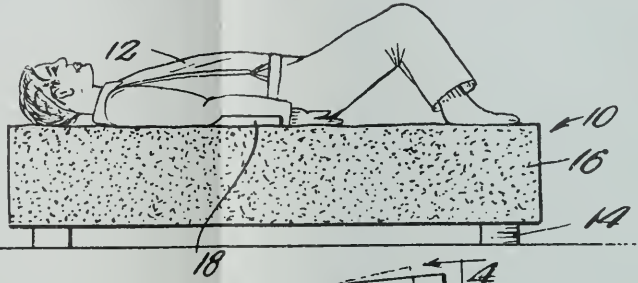


Fig. 2.

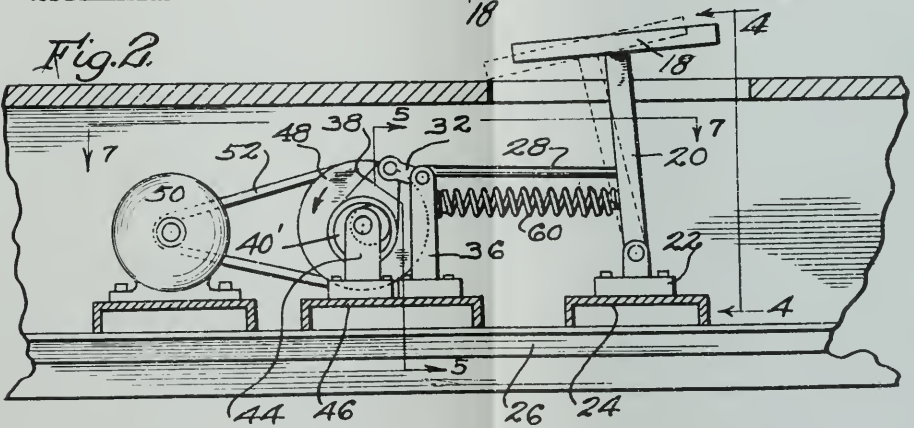
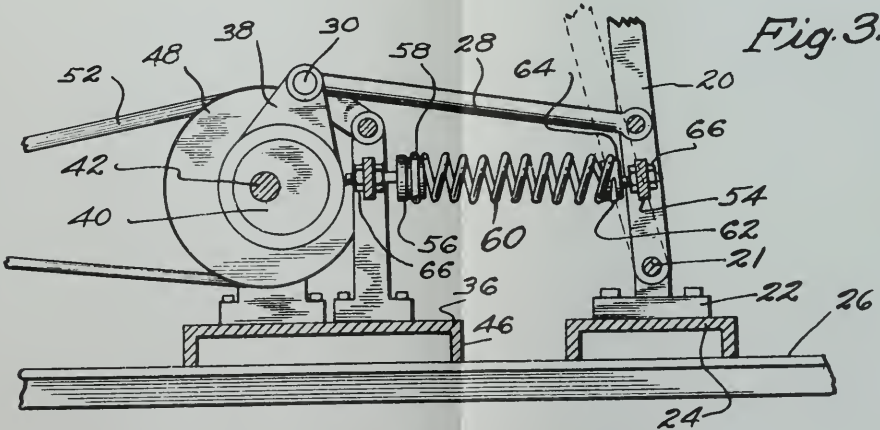


Fig. 3.



INVENTOR.  
 Bernard H. Stauffer  
 BY





Los Angeles, California.  
January 17, 1940.

JAN 25 1940

C 615  
B

MAIL DIVISION

JAN 24 1940

OFFICE

DIV. 55  
Bernard H. Stauffer

S. N. 222,327  
Filed, Aug. 22, 1939  
For, Muscle Relaxing  
Machines.

Division No. 55  
Room No. 6833  
Paper No. 5

Commissioner of Patents  
Washington, D.C.



Sir:

In response to office action dated November 8, 1939, the above entitled application is amended as follows, and it is requested that this amendment be inserted in the original document.

Cancel claims 1, 3, 5, and 7.

Add the following new claim:

~~(10)~~ A muscle relaxing machine comprising a couch-like structure for repose of a human body in the top surface of which a slot-way is formed and through which a vertically directed and oscillatable support for a <sup>single</sup> flat rectangular applicator is adapted to <sup>oscillate</sup> ~~move~~, and means to oscillate said applicator axially of the length of said couch-like structure whereby zonular areas of the body may be massaged by mechanical manipulation in a substantially horizontal plane.

Per C  
"C"  
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H

Claims 1, 3, 5, and 7 have been canceled in view of the record. Claims 8 and 9 are retained, being again submitted for action on their merits and as supported by the following argument.

CH 1

